TABLE OF CONTENTS

PETITION FOR WRIT OF CERTIORARI

Page

I. Basis of This Court's Jurisdiction 1

II. Summary and Short Statement of the Matter Involved 2

1. Statement of the Case 2
2. The Statutes Involved 3
3. Plaintiff's Case 4
4. The Decisions Below 8

III. The Questions Presented 9

IV. The Reasons Relied on for Allowance of the Writ . 10

BRIEF IN SUPPORT OF PETITION

Argument 15

Point 1. The Decision of the Court of Appeals is Contrary to the Express Provisions of the Trade-Mark Act of 1946. 15

Point 2. The Decision of the Court of Appeals is Contrary to the Settled Law that Trade-Marks Do Not Lose Their Distinctiveness and Become Generic, Except through Abandonment Acquiescence, or Laches on the Part of the Trade-Mark Owner. There is no Evidence of Abandonment, Acquiesence or Laches Here. On the Contrary Petitioner has Shown Conclusively that it has Made Every Possible Effort to Protect its "Cube Steak" trademark and to Notify the Trade of its Trade-Mark Rights. The Knowledge or Ignorance of the General Public is Immaterial in this Situation. 17

Page

Point 3. The Rights to Registration Granted Under the Trade-Mark Act of 1946 are Very Valuable Rights to the Trade-Mark Owner, Because of the Substantive and Procedural Advantages Conferred. This Right to Registration is not to be Denied when the Applicant Has Made Adequate Proof of his Right to Registration Within the Terms of the Trade-Mark Act, as Applicant has done Here. 19

TABLE OF CASES.

American Steel Foundries v. Robertson, 282 US 209; 67 L. Ed. 953 and 269 US 372 1

Beckwith v. Commissioner, 252 US 538; 64 L. Ed. 705 . 2, 19

Burton v. Stratton, 12 F. 696 at 702 (CCED, Mich. 1882) . 18

California Cyanide Co. v. American Cyanide Co., 40 F. (2d) 1013 at 1014–15 (CCPA 1930) 18

Celluloid Mfg. Co. v. Cellonite Co. 32 F. 94 at 98 (CCNJ 1887) 18

Coca-Cola Co. v. Koke Co. of America, 254 US 143 at 146, 65 L. Ed. 189 (1920) 18

Cube Steak Machine Co. Inc. v. Racoff (Rp. 141–150) . 7

Fairbank Co. N. K. v. Central Lard Co. 64 F. 133 at 136–7 (CCSDNY 1894) 18

Ford v. Foster, L. R. 7 Ch. 611 at 628 (1872) . . 18

Havana Cigar & Tobacco Factories v. Oddenino, 41 RP. C. 47 at 63 (1923) 18

Hygeia Distilled Water Co. v. Hygeia Ice Co. 70 Conn. 516 at 533–4; 40 Atl. 534 (1898 18

	Page
Imperial Cotton Sales Co. v. N. K. Fairbanks Co. 270 F. 686 at 687; 50 App. D. C. 250 (C.A.D.C. 1921)	18
Jacobs v. Beecham, 221 US 263 at 272; 55 L. Ed. 729 (1910)	18
Powell v. Birmingham Vinegar Brewery Co. L. R. 2 Ch. 54 (1896)	18
Saxlehner v. Eisner and Mendelson Co. 179 US 19, 45 L. Ed. 60 (1900)	17
Selchow v. Baker, 93 N. Y. 59 at 66 and 69 (Unreported in N. E. Reporter (1883)	18
Stone & Co. Ltd. v. Steelace Mfg. Co. 48 R. P. C. 406 to 418 (1929)	18
Telechron, Inc. v. Telicon Corp. 97 F. Supp. 131 at 149–154 (D.C.D. Del. 1931)	18
Winthrop Chemical Co. Inc. v. Blackman, 150 N. Y. Misc. 229, 268 N.Y.S. 647, 24 T.M.R. 106 at 109–110 (N.Y. Sup. Ct. N.Y. County 1934)	18

STATUTES.

15 USC 22, 1052, 1054, 1127	3

TEXTBOOKS AND LEGAL ARTICLES

Callmann on Unfair Competition and Trade-Marks (2d. Ed.) (p. 1149–1150)	18
Nims on Unfair Competition and Trade-Marks (45h Ed.) Sec. 407a, p. 1261–1264	17
Derenberg Article – The Sixth Year under the Lanham Act (98 USPQ Part 11, Sept. 14, 1953)	11

In the

Supreme Court of the United States.

OCTOBER TERM, 1953.

No.

WILLIAM F. SPANG, ET AL. CO-PARTNERS, DOING BUSINESS AS CUBE STEAK MACHINE COMPANY,
PETITIONERS,
v.
ROBERT C. WATSON, COMMISSIONER OF PATENTS,
RESPONDENT.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, William F. Spang, et al. co-partners doing business as Cube Steak Machine Company, respectfully pray for a Writ of Certiorari directed to the Court of Appeals for the District of Columbia Circuit to review a judgment of that Court entered August 21, 1953, denying (Rp. 263) plaintiff's petition for rehearing in an action brought to register their Trade-Mark "Cube Steak", originated by them, and used by them on Machines for Tenderizing Meat.

I. BASIS OF THIS COURT'S JURISDICTION

This Court's jurisdiction to review the judgment of the Court of Appeals for the District of Columbia Circuit is based on Title 28 USC Sec. 347, and Title 15 USC Sec. 1122. Jurisdiction has been recognized in *American Steel Foun-*

Time for filing petition for writ of certiorari was extended to Dec 4, 1953 by order of the Chief Justice dated Nov. 14, 1953 (R.p. 264).

dries v. *Robertson,* 262 U.S. 209, 67 L.Ed. 953, and 269 U.S. 372; 70 L.Ed. 317; and *Beckwith* v. *Commissioner,* 252 U.S. 538, 64 L.Ed. 705.

II. SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED.

1. Statement of the Case

This action was brought under RS4915 (35 USC 63 and 15 USC 1071) against the Commissioner of Patents to direct him to register the trade-mark "Cube Steak" for Machines for Tenderizing Meat in Class 23, Cutlery, machinery and tools and parts thereof, under Section 2(f) of the Trade-Mark Act of July 5, 1946, (15 USC Chap. 22; 60 Stat. 427). The Examiner had refused the application on the ground that "Cube Steak" was not a proper trade-mark because it was a generic term for a kind of meat. *The only evidence supporting the Examiner's position was two patents in which the words "cube" or "cubed" steak were misused.* The Assistant Commissioner affirmed on the ground that applicant had not put in any of its advertising in the record and had not sufficiently proved its case.

The plaintiff then filed this suit in the U. S. District Court for the District of Columbia, and in a suit *de novo* supplemented its evidence in the Patent Office by a great mass of documentary evidence, and oral testimony of trade witnesses.

This evidence overwhelmingly established that in the trade in which it is used, the meat-market, hotel and restaurant trade, the trade-mark "Cube Steak" is distinctive of plaintiff's machines, is not a generic term, and is clearly entitled to registration under Section 2(f) of the Trade-Mark Act of 1946.

Again, the only evidence offered by the Patent Office was the same two patents relating to tenderizing machines in which the words "cube" or "cubed" steak were misused.

The District Court held with no proof whatever that the

plaintiff's trade-mark in the mind of the public had become generic of the kind of meat processed on the petitioner's machines (Opinion Rp. 7-8). On appeal the Court of Appeals affirmed (Opinion Rp. 240; reported in 205 F (2d) 703; and 97 USPQ 290).

2. The Statutes Involved

The statutes involved are Section 2(f) of the Trade-Mark Act of 1946 (15 USC 1052) which reads as follows:

> "No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the Principal Register on account of its nature unless it—
>
> (Here follows the exceptions in Paragraphs (a), (b), (c), (d) and (e) not pertinent here.)
>
> '(f) Except as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration.' "

and Section 45 of the Trade-Mark Act of 1946 (15 USC 1127) defining Abandonment, which provides:

> *"Abandonment of mark. A mark shall be deemed to be 'abandoned'—*
>
> (a) When its use has been discontinued with intent not to resume. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie abandonment.

(b) *When any course of conduct of the registrant, including acts of omission as well as commission, causes the mark to lose its significance as an indication of origin.*''

3. Plaintiff's Case

The plaintiff's evidence showed conclusively and without contradiction the following facts:

a) The trade-mark ''Cube Steak'' was originated in 1925 by Joseph P. Spang, founder of the plaintiff company, who devised a machine to make cross-cuts in a piece of steak, leaving a portion uncut to hold the meat together. The purpose was to tenderize the meat and to provide a cheaper cut of steak. Mr. Spang then started manufacturing the machines and selling them to meat markets, restaurants and hotels under the name ''Cube Steak Machine''.

b) The plaintiff company has continued the same business of manufacturing meat tenderizing machines to this day. Mr. Spang's first machine is shown in his patent No. 1,570,792, granted January 26, 1926 for *Meat Tenderer* (Plf's. Exh. 3, R. 85). Since that time the plaintiff company has designed 60 or more improved steak tenderizing machines, most of them patented. Previously steaks were commonly tenderized by pounding them with hammers, mallets and the like. But prior to Mr. Spang's development there never had been any commercial practice of cutting slits in steaks to tenderize them (Rp. 30).

c) The plaintiff company has used three distinct types of cuts for tenderizing meats on its machines 1) cross-cuts on the top surface of the meat, 2) cuts in one direction on one surface and at right angles on the bottom surface (called ''Super Cube Steak'') and 3) a series of disconnected cuts called ''knitting''. Machines making the first type of cut were made until 1940; machines making the second and third types of cuts are made today. The plaintiff company

has used its trade-mark "Cube Steak" on these three different types of machines.

d) Since 1925 the plaintiff company has sold 160,000 to 170,000 of its "Cube Steak" tenderizing machines in the United States and some 3000 to 5000 more in foreign countries. The business grew slowly from 1925, from about 360 machines a year and $25,000 annual business to 6000 machines yearly and $1,000,000 annual business. The average is now around 4,000 machines yearly, with an annual business of $750,000. The plaintiff company has a national sales organization with 22 district sales managers and about 400 jobbers and dealers selling their machines throughout the United States.

e) The plaintiff company has registered its "Cube Steak" trade-mark for Machines for Slitting Meat, Registration No. 271,479, registered June 3, 1930 (Rp. 113) under the Act of March 19, 1920.

f) The "Cube Steak" trade-mark has been in common use in meat markets and in their advertising, for many years, *to identify meat processed on the plaintiff's machines. But every such use is a proper use.* These meats have actually been tenderized on the plaintiff's machines in a particular manner, as the "Cube Steak" mark certifies. Anyone who has used plaintiff's trade-mark "Cube Steak" improperly, i.e. to identify meat not processed on plaintiff's machines, is notified of plaintiff's trade-mark rights, and invariably the wrongful use has stopped.

g) The generic name for meats processed on plaintiff's machines is *tenderized meat or steak* and for the machines *tenderizing machines* or *meat tenderers.*

The Patent Office has its own classification for these machines under Class 17, called *Meat Tenderers.* Plaintiff put in evidence 69 patents from 1864 to 1951 showing the common use of *the generic name* for these machines: meat tenderers, machine for tenderizing steaks, meat tenderizing machine, and the like. The Classified Directory of the

National Wholesale Exposition carries a heading "Steak Machines and Tenderizers". Plaintiff's and its competitors' machine are commonly advertised in the trade journal as "meat tenderizers". Restaurants commonly advertise Tenderized Steaks (Rp. 52-54).

h) Three large scrapbooks of plaintiff's advertising constantly proclaimed to the trade—retail meat markets, hotels and restaurants—that "Cube Steak" was plaintiff's trade-mark identifying its own meat tenderizing machines (Plf's. Exh. 13). Plaintiff company has spent some $306,000 in advertising its "Cube Steak" trade-mark to the meat market, hotel and restaurant trade from 1931 to 1951.

Plaintiff put in evidence a large group of letters received over the years referring to plaintiff's "Cube Steak" machines (Plf's. Exh. 21) (Rp. 197-210); and Swift & Company's advertisement of "Swift's Cube Steak Beefroll" which states:

> "This roll is suitable for use in any steak tenderizing machine, but steaks to be called "Cube Steaks" should be made on the genuine "Cube Steak" machine (Plf's. Exh. 21, Rp. 195).

This evidence and the testimony of trade witnesses Katz (Rp. 11) Mendelsohn (Rp. 17), Hackerman (Rp. 19) White of the First National Stores (Rp. 101) and Fitz-Gibbon of Kroger Co. Inc. (Rp. 107) showed indisputably that in the trade the mark "Cube Steak" means petitioner's machines, and has become distinctive of petitioner's machines.

i) Plaintiff's competitors who make meat tenderizing machines have their own trade marks for their own machines, such as "Steak Maker", "Tender Steak", "Tender-Diced Steak", "Tenderet", "Kroskut", "Steak Master" and "Delicator"—and these trade marks are registered in the Patent Office. None of them uses "Cube Steak" to identify its machine. When a competitor describes his ma-

chine generically he refers to it by its proper generic name "Tenderizing machine" or "Steak Tenderer".

j) The plaintiff company has waged a continuous campaign to notify the trade of its rights in its "Cube Steak" trade-mark as identifying its own tenderizing machines and meats tenderized on them. Its rights were sustained in 1933 in an adjudicated case in Massachusetts, *Cube Steak Machine Company* v. *Racoff*, (Rp. 141-151), and plaintiff's rights were again sustained in a Federal Trade Commission decision in 1940 (Rp. 151-2).

The plaintiff company and its predecessors have advertised extensively in trade journals and have sent out thousands of notices notifying the trade of its trade-mark rights. Every wrongful user of plaintiff's "Cube Steak" trade-mark, whose meat is not processed on one of plaintiff's tenderizing machines is notified immediately of plaintiff's trade-mark rights, and if necessary is again notified by petitioner's attorneys. Invariably the wrongful use stops. Only one infringement suit has ever had to be brought.

Plaintiff has protested to the Patent Office against wrongful use of its trade-mark in patent applications. An instance is Anderson & Stebber patent No. 1,907,413, granted May 2, 1933 (Rp. 219-224)—which used the words "cube steak" in a generic sense. On notice Mr. Anderson agreed not to use those words any more (Letter Rp. 218).

In Reinwald patent No. 2,186,429, granted January 9, 1940 (Rp. 215-217) plaintiff company protested to Mr. Reinwald and to the Commissioner of Patents against the improper use of the words "Cube Steak" therein. As a result of similar protests, the Patent Office adopted a Regulation against devices or compounds by their trademark names unless accompanied by a generic description of the device or compound. Sec. 608.01 (v) of the Current Manual of Patent Examining Procedure provides:

"Although the use of trade-marks having definite

meanings is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might endanger their validity as trade-marks. The Examiner should not permit the use of language such as T.M. (trade mark)."

4. The Decisions Below

The District Court found (Rp. 4-5; 7-8):

> "The plaintiff's convincingly proved that they have made great efforts toward policing the words "Cube Steak" since they and their predecessors started business over a quarter of a century ago. However, whatever their meaning originally may have been, and regardless of the policing, the words now appear to be identified as the name of the product and not the producer" . . . the plaintiffs have not shown that the general public believes the words indicate a producer and not a product. It may well be that those who are in the trade, i.e. those who use the machine, regard "Cube Steak" as a steak made by a "Cube Steak Machine", but if the term "Cube Steak" is generic of a type of meat, it is also the generic name of the machine which makes such meat."

As stated above, the only evidence put in by the Patent Office in the entire case were the two instances of misuse of petitioner's mark appearing in the two patents (Rp. 7). The Court of Appeals nevertheless affirmed.

Very plainly, both the District Court and Court of Appeals confused the present application to register its Trade-Mark "Cube Steak" for *Machines for Tenderizing Meat*, with petitioner's pending application to register its Trade-Mark "Cube Steak" as a *certification mark for Beef, Veal, Mutton, Lamb and Pork Steaks and Cutlets*—used upon the goods (i.e. the meats) to indicate that the goods were ten-

derized by machines manufactured and sold by the applicant (petitioner)—as the Trade-Mark Act of 1946 expressly permits, Sec. 4, (15 USC 1054). See Stipulation, Rp. 5-6.

The Courts below did not realize that petitioner *is* properly entitled to register "Cube Steak" as a *certification mark for meats.* Thus the premise on which the District Court based its decision, "if the term 'Cube Steak' is generic of a type of meat, it is also the generic name of the machine which makes such meat" was unsound.

The decision of the Courts below hold that two instances of misuse of a Trade-Mark are sufficient evidence to establish that the mark has become generic, has lost its significance as an indication of origin, and hence is not entitled to registration, despite overwhelming evidence (69 patents and many other instances) that a generic name for the goods exists and is in common use in the trade, and that in the trade the mark has not become generic. Very clearly it was not the intent of Congress that trademarks could be held to have become public property, and hence unregistrable under Sec. 2(f), on any such evidence as this.

III. THE QUESTIONS PRESENTED

1. Whether a trade-mark, which in the trade in which it is used indisputably means the applicant's machines, and hence has become distinctive of his goods in commerce under Sec. 2(f) of the Trade-Mark Act of 1946, can nevertheless be denied registration on the ground that in the minds of the general public the trade-mark has become generic of the product processed by applicant's machines.

2. Whether a trade-mark, which in the trade in which it is used indisputably means the applicant's machines, and hence has become distinctive of his goods in commerce under Sec. 2(f) of the Trade-Mark Act of 1946, can nevertheless be denied registration on the ground that in the minds of the general public the trade-mark has become generic of the product processed by applicant's machines,

when the Trade-Mark Act itself in Sec. 45 (15 USC 1127) makes the test for determining whether a mark has lost its significance as an indication of origin, the course of conduct of the registrant (or applicant) including his acts of omission as well as commission, and not what the mark may mean in the minds of the general public.

3. Whether a trade-mark, which is conclusively shown to have been in exclusive and continuous use by the applicant for more than twenty-five years on his machines, and which has become distinctive of his machines in the trade in which it is used, and a generic and descriptive name for the machines exists and is in common use in that trade, and the applicant has constantly notified the trade of his Trade-Mark rights, and the trade has uniformly respected them, can nevertheless be denied registration under Section 2(f) of the Trade-Mark Act of 1946, on the ground that in the mind of the general public the mark has become generic of the product processed by the applicant's machines, when the Trade-Mark Act itself and the settled law makes the test for determining, whether the mark has lost its significance as an indication of origin, the course of conduct of the registrant (or applicant), and not the state of mind of the general public.

IV. THE REASONS RELIED ON FOR ALLOWANCE OF THE WRIT.

Your petitioner respectfully prays that the Writ be allowed for the following reasons:

1. Because the decision of the Court of Appeals is contrary to the express provisions of the Trade-Mark Act of 1946, which itself makes the test for determining when a mark has lost its significance as an indication of origin, solely *the course of conduct of the registrant,* including acts of omission as well as commission, and not what the mark may mean to the general public.

2. Because the decision of the Court of Appeals is contrary to settled rules of the common law of Trade-Marks,

as established by the decisions of this Court and other courts, and embodied in the Trade-Mark Act of 1946, that Trade-Marks do not lose their distinctiveness and become generic, except through abandonment, acquiescence, or laches on the part of the trade-mark owner, and that the knowledge or ignorance of the general public as to the significance of the mark is immaterial.

3. Because the decision of the Court of Appeals in effect confiscates and destroys the valuable rights of the petitioner in its "Cube Steak" Trade-Mark, built up through long years of hard work, $306,000 spent in advertising, and constant effort to give the trade better tenderizing machines, and hands them over to the petitioner's competitors, most of whom have vastly larger financial resources than the petitioner—to the inevitable confusion and detriment of the general public, to whom the "Cube Steak" Trade-mark previously has meant at least that they were getting meat tenderized in a particular manner on petitioner's machines, whether they realized it or not.

4. Because the decision of the Court of Appeals has aroused great concern in the Trade-Mark Bar and among trade-mark owners throughout the United States, in placing many valuable trade-marks in jeopardy, and as being contrary to the express intent of Congress. Professor Walter J. Derenberg of New York University, who has been Counsel and Legal Advisor to the Patent Office in matters arising under the Trade-Mark Act of 1946, has thus commented on the case in his Report "The Sixth Year of Administration of the Lanham Trade-Mark Act of 1946" submitted to the Patent, Trade-Mark and Copyright Section of the American Bar Association at the Convention in Boston, August 23, 1953 (reported in 98 USPQ, Part II, September 14, 1953):

> **"The 'Cube Steak' case appears to raise an interesting and important issue which seems to have received rather inadequate consideration by the Patent Office and by the**

courts. Apparently it was the plaintiff's position that, similar to the Bayer 'Aspirin' case, the mark 'Cube Steak' might have lost its original significance as far as the general public was concerned but that at least throughout the entire trade, the words had retained their meaning and that plaintiff, in the absence of any act of omission or commission, should not be held to have lost the trade-mark solely because of the attitude of the general public. In most countries of the world a trade-mark will not be held lost solely because of the public's attitude with regard thereto unless it can also be shown that the trade-mark significance of the word has completely disappeared even among members of the industry involved. The 'Cube Steak' case squarely raises the question which has never been decided again in this country since Judge Learned Hand's decision as a district judge in the Bayer 'Aspirin' case, whether recognition of a trade-mark by trade and industry will suffice to preserve its validity even though the general public may no longer associate the mark with the products of one particular manufacturer. Perhaps the Court of Appeals* or the United States Supreme Court may have an opportunity to rule upon this basic trade-mark problem either in the 'Cube Steak' case or in some future litigation."

Wherefore your petitioner respectfully prays that a Writ of Certiorari be issued out of and under the seal of this Honorable Court, directed to the Court of Appeals for the District of Columbia Circuit, directing that Court to certify and to send to this Court for its review and determination on a day certain to be named therein, a full and complete transcript of record and of proceedings in the case

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* At the time this was written the petition for rehearing was still pending in the Court of Appeals.

numbered and entitled on its docket Appeal No. 11508, William F. Spang et al, co-partners doing business as Cube Steak Machine Company, plaintiffs-Appellees v. Robert C. Watson, Commissioner of Patents, Defendant-Appellee, and that your Petitioner may have such other and further relief in the premises as to this Honorable Court may seem meet and just.

William F. Spang, et al, Petitioners,

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No.

WILLIAM F. SPANG, ET AL. CO-PARTNERS, DOING BUSINESS AS CUBE STEAK MACHINE COMPANY,
PETITIONERS,
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ROBERT C. WATSON, COMMISSIONER OF PATENTS,
RESPONDENT.

ON PETITION FOR WRIT OF CERTIORAR TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT.

BRIEF FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

ARGUMENT

Point 1. The Decision of the Court of Appeals is Contrary to the Express Provisions of the Trade-Mark Act of 1946.

Section 2(f) of the Trade-Mark Act of 1946 expressly provides:

> . . . "Nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that

the mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration."

Petitioner fulfilled all these requirements by conclusive evidence, as shown in Plaintiff's Case above.

The District Court and Court of Appeals, however, denied registration on the ground that petitioner's "Cube Steak" trade-mark in the mind of the general public had become generic of the meat processed on petitioner's machines, and hence had lost its significance as an indication of origin, thus holding that petitioner's trade-mark had become abandoned. But Section 45 of the Trade-Mark Act of 1946 expressly provides:

> "*Abandonment of Mark. A mark shall be deemed to be 'abandoned'*—
>
> (a) When its use has been discontinued with intent not to resume. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie abandonment.
>
> (b) *When any course of conduct of the registrant, including acts of omission as well as commission, causes the mark to lose its significance as an indication of origin.*"

Thus the Trade-Mark Act expressly makes the test of whether a mark has lost its significance as an indication of origin, and hence abandoned, *the course of conduct of the registrant, including acts of omission as well as commission,* and not what the mark may mean to the general public. The general public, of course, is not, and cannot be expected to be, informed on commercial matters.

Point 2. The Decision of the Court of Appeals is Contrary to the Settled Law That Trade Marks Do Not Lose Their Distinctiveness and Become Generic, Except through Abandonment, Acquiescence, or Laches on the Part of the Trade Mark Owner. There is no Evidence of Abandonment, Acquiescence or Laches Here. On the Contrary Petitioner has Shown Conclusively That it has Made Every Possible Effort to Protect Its "Cube Steak" trade-mark and to Notify the Trade of its Trade-Mark Rights. The Knowledge or Ignorance of the General Public is Immaterial in this Situation.

The leading case on loss of distinctiveness in a trade-mark is *Saxlehner* v. *Eisener and Mendelson Co.*, 179 US 19, 45 L.Ed. 60 (1900), which involved the exclusive rights to the trade-mark "Hunyardi" used on bitter waters bottled in Hungary. The Court found that the mark had lost its distinctiveness and had become generic, but because there was no abandonment, nor acquiescence, this was not fatal. Mr. Justice Brown said (p. 33):

> "The evidence shows that these Hungarian bitter waters were largely known in this country as Hunyardi waters, and that in a certain sense Hunyadi had become a generic word for them. Of course, if it became such with the assent and acquiescence of Saxlehner, he could not thereafter assert his right to its exclusive use. *But as this appropriation was made against his constant protest, and as he apparently made every effort in his power to put a stop to the use of it, it ought not to be charged up against his claim that the word had become generic.*"

The plaintiff was found guilty of laches against the particular defendant, however, and an injunction was denied as to the use of "Hunyari," but was nevertheless granted against defendant's fraudulent copying of the bottle and label. See Nims on Unfair Competition and Trade Marks (4th Ed.) Sec. 407a, p. 1261-1264. See also:

Selchow v. *Baker,* 93 N.Y. 59 at 66 and 69 (Unreported in N.E. Reports (1883)

Callmann on Unfair Competition and Trade Marks (2d Ed.) p. 1149-1150)

Winthrop Chemical Co., Inc. v. *Blackman,* 150 N.Y. Misc. 229, 268 N.Y.S. 647, 24 T.M.R. 106 at 109-110 (N.Y. Sup. Ct. N.Y. County 1934).

Burton v. *Stratton,* 12 F. 696 at 702 (C.C.E.D. Mich. 1882).

N. K. Fairbanks Co. v. *Central Lard Co.,* 64 F. 133 at 136-7 (C.C.S.D.N.Y. 1894).

Imperial Cotto Sales Co. v. *N. K. Fairbanks Co.,* 270 F. 686 at 687; 50 App. D.C. 250 (C.A.D.C. 1921).

California Cyanide Co. v. *American Cyanide Co.,* 40 F. (2d) 1013 at 1014-15 (C.C.P.A. 1930).

Telechron, Inc. v. *Telicon Corp.,* 97 F.Supp. 131 at 149-154 (D.C.D. Del. 1931).

Coca-Cola Co. v. *Koke Co. of America,* 254 U.S. 143 at 146, 65 L.Ed. 189 (1920).

Jacobs v. *Beecham,* 221 U.S. 263 at 272; 55 L.Ed. 729 (1910).

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Point 3. The Rights to Registration Granted Under the Trade Mark Act of 1946 are Very Valuable Rights to the Trade Mark Owner, because of the Substantive and Procedural Advantages Conferred. This Right to Registration is not to be Denied when the Applicant Has Made Adequate Proof of his Right to Registration Within the Terms of the Trade Mark Act, as Applicant has done Here.

This Court in *Estate of P. D. Beckwith* v. *Commissioner of Patents,* 252 U.S. 538, 64 L.Ed. 705 (1919) has previously reversed the Court of Appeals of the District of Columbia in a similar suit to register a trade mark under the 1905 Act. Mr. Justice Clarke there said (p. 544-546):

> "In this connection it must be noted that the requirement of the statute that no trademark shall be refused registration, except in designated cases, is just as imperative as the prohibition of the proviso against registration in cases specified."
>
> . . . . . .
>
> "Of course, refusal to register a mark does not prevent a former user from continuing its use, but it deprives him of the benefits of the statute, and this should not be done if it can be avoided by fair, even liberal, construction of the act, designed, as it is, to promote the domestic and foreign trade of our country."

In the present case the right to registration was denied by the Court's assuming, without evidence, that the "Cube Steak" trade mark had become generic and had lost its significance as an indication or origin in the minds of the general public. In their decisions the Court of Appeals and District Court have very plainly misconstrued Section 2(f) of the Trade Mark Act of 1946, and its clarifying Section 45 defining "Abandonment of mark." In so doing the Courts below have denied Petitioner the valuable right of registration expressly given it under Section 2(f), and have in effect confiscated petitioner's "Cube Steak" trade

mark, declaring it to be public property free to all of petitioner's competitors to use, to the inevitable confusion of the trade and detriment of the general public. An astounding result of the Court of Appeals' decision is that it gives petitioner's competitors the right to use petitioner's "Cube Steak" trade mark and the benefit of its good will, built up by long years of petitioner's enterprise, constant efforts to make a better machine, and $306,000 spent in advertising. The only reason that petitioner's "Cube Steak" trade-mark is known to the public at all is because of petitioner's enterprise and advertising. Petitioner's competitors all have their own trade-marks for their own meat tenderizing machines. But their trade-marks are not as well known, and petitioner is thus penalized for its own success and enterprise.

The beneficiaries of the Court of Appeals' decision are petitioner's competitors, most of whom are much larger than petitioner. Petitioner's success naturally attracted competition and copying by several larger concerns manufacturing meat merchandising machines and equipment. The net worth and annual business of petitioner and its principal competitors are as follows:

	Net Worth	*Annual Business*
Cube Steak Machine Company	$ 400,000	$ 750,000
Hobart-Federal Engineering Co.	16,600,000	30,000,000
U.S. Slicing Machine Co.	3,700,000	Unavailable
Toledo Scale Co.	11,600,000	Unavailable
Sanitary Scale Co.	Over 1,000,000	Unavailable

The Court of Appeals decision thus confiscates petitioner's valuable "Cube Steak" trade-mark and its good will and hands them over to petitioner's competitors to use —to the ruin of petitioner's business, the unjust enrichment of petitioner's competitors, and the inevitable confusion to the trade and the general public. The general public when

it buys a "Cube Steak" now gets a piece of meat processed in a particular manner on one of petitioner's machines. But if all manufacturers of meat tenderizing machines can use petitioner's "Cube Steak" trade-mark, this certification and guarantee to the public of quality tenderizing is completely lost. It was not the intention of Congress to despoil a trade-mark owner and to award such windfalls to his competitors by declaring his trade-mark to have become generic and available to everyone to use—on the facts established in this case. The Court of Appeals has grievously misinterpreted Sections 2(f) and 45 of the Trade-Mark Act, and has entirely overlooked the provision for registration of certification marks in Section 4.

We respectfully submit that the Petition for Writ of Certiorari should be granted, for the reasons stated. The Court of Appeals for the District of Columbia has decided a question of substance relating to the construction of Section 2(f) of the Trade-Mark Act of 1946, which is clearly contrary to the express intention of Congress, and which should be settled by this Court.

Respectfully submitted,

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INDEX

	Page
Opinions below	1
Jurisdiction	1
Question presented	2
Statute involved	2
Statement	3
Argument	5
Conclusion	11

CITATIONS

Cases:

Amiesite Asphalt Co. v. *Interstate Amiesite Co.*, 72 F. 2d 946	8
Armstrong Co. v. *Nu-Enamel Corp.*, 305 U.S. 315	9
Basic Food Materials v. *Keyes Fibre Co.*, 162 F. 2d 422	10
Bayer Co., Inc. v. *United Drug Co.*, 272 Fed. 505	7
Beckwith v. *Commr. of Patents*, 252 U.S. 538	10
Best & Co. v. *Miller*, 167 F. 2d 374, certiorari denied, 335 U.S. 818	9
Canal Co. v. *Clark*, 13 Wall. 311	10, 11
Coca-Cola Co. v. *Koke Co.*, 254 U.S. 143	5
Comstock v. *Group of Investors*, 335 U.S. 211	8
Curtis-Stephens-Embry Co. v. *Pro-Tek-Toe Skate Stop Co.*, 199 F. 2d 407	9
Dixie Rose Nursery v. *Coe*, 131 F. 2d 446, certiorari denied, 318 U.S. 782	10
Dupont Cellophane Co. v. Waxed Products Co., 85 F. 2d 75, certiorari denied, 304 U.S. 575	6, 7
Durable Toy & Novelty Corp. v. *J. Chein & Co.*, 133 F. 2d 853, certiorari denied, 320 U.S. 211	7, 10
Elgin Nat'l Watch Co. v. *Illinois Watch Case Co.*, 179 U.S. 665	10
Faulkner v. *Gibbs*, 338 U.S. 267	8
General Pictures Co. v. *Western Electric Co.*, 304 U.S. 175	8
Ippolito v. *Nancy Ann Dressed Dolls*, 184 F. 2d 201	10
Kellogg Co. v. *Nat. Biscuit Co.*, 305 U.S. 111	5, 8
Mission Dry Corp. v. *Seven-Up Co.*, 193 F. 2d 201	6
Philadelphia Inquirer Co. v. *Coe*, 38 F. Supp. 427, affirmed, 133 F. 2d 385, certiorari denied, 318 U.S. 793	5
Schulmerich Electronics v. *J. C. Deagan, Inc.*, 202 F. 2d 772	10

Cases—Continued

	Page
Singer M'f'g Co. v. *June M'f'g Co.*, 163 U.S. 169	8, 10
Skinner Mfg. Co. v. *General Food Sales Co.*, 52 F. Supp. 432, affirmed, 143 F. 2d 895, certiorari denied, 323 U.S. 766	7
Skinner Mfg. Co. v. *Kellogg Sales Co.*, 143 F. 2d 895, certiorari denied, 323 U.S. 766	10
Standard Paint Co. v. *Trinidad Asph. Co.*, 220 U.S. 446	10
Telechron, Inc. v. *Telicon Corp.*, 198 F. 2d 903	10
Trustees for A. P. Shoe Patents v. *J. McCreery & Co.*, 49 F. 2d 1068	5
Walgreen Drug Stores v. *Obear-Nester Glass Co.*, 113 F. 2d 956, certiorari denied, 311 U.S. 708	9
Warner & Co. v. *Lilly & Co.*, 265 U.S. 526	10
Wilson v. *Southern Ry. Co.*, 147 F. 2d 165	2

Statutes:

Act of July 19, 1952, 66 Stat. 792:	
Section 1 (reenacting 35 U.S.C. 145, 146)	4
Section 5	4
Act of May 24, 1949, 63 Stat. 110 (Repealing 15 U.S.C. 1122), Section 142	2
R.S. 4915, 35 U.S.C. (1946 Ed.) 63	4
Trade-Mark Act of 1946 (Lanham Act) 60 Stat. 427, 15 U.S.C. 1051, *et al.*:	
Section 1	8
Section 2	2
Section 2(e)	3
Section 2(f)	3, 5, 7
Section 21	4
Section 45	5, 6
Section 45(a)	6
Section 45(b)	6

In the Supreme Court of the United States

OCTOBER TERM, 1953

No. 488

WILLIAM F. SPANG, ET AL., CO-PARTNERS, DOING BUSINESS AS CUBE STEAK MACHINE COMPANY, PETITIONERS

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

OPINIONS BELOW

The memorandum opinion of the District Court for the District of Columbia (R. 4-5) is reported at 104 F. Supp. 126. The opinion of the Court of Appeals (R. 240-242) is reported at 205 F. 2d 703.

JURISDICTION

The judgment of the Court of Appeals was entered on May 7, 1953 (R. 243). A petition for

rehearing was denied on August 21, 1953 (R. 263). On November 14, 1953, Chief Justice Warren extended the time to file a petition for writ of certiorari to and including December 4, 1953 (R. 264). The petition for a writ of certiorari was filed on December 4, 1953. The jurisdiction of the Court is invoked under 28 U.S.C. 1254(1).[1]

QUESTION PRESENTED

Whether petitioners are entitled to the registration of "Cube Steak" as a trade-mark for meat-tenderizing machines under Section 2(f) of the Trade-Mark Act of 1946, although the Patent Office found the mark was generic and no longer distinctive of petitioners' machines, and both courts below agreed that the petitioners had failed to show that the words were distinctive.

STATUTE INVOLVED

Section 2 of the Trade-Mark Act of 1946, 60 Stat. 428-429, 15 U.S.C. 1052, provides in pertinent part:

> No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it * * *.
>
> * * * * *

[1] 15 U.S.C. 1122, also relied on by petitioners, was repealed by Section 142 of the Act of May 24, 1949, 63 Stat. 110.

While the petition seeks to review the "judgment" of the court of appeals of August 21, 1953, denying the petition for rehearing (Pet. 1), it is assumed that the intention was to obtain review of the judgment of the court of appeals of May 7, 1953 affirming the judgment of the district court. Cf. *Wilson* v. *Southern Ry. Co.*, 147 F. 2d 165 (C.A. 5).

(e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive * * *.

(f) Except as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration.

STATEMENT

Petitioners applied for the registration of "Cube Steak" as a trade-mark for meat-tenderizing machines. Registration was refused by the Examiner of Trade-Marks on the ground that "Cube Steak" is generic for a machine designed to tenderize meat (R. 230); the Examiner could "conceive of no expression more indigenous to this art than the notation 'cube steak' for meat tenderizing machines. Its very aptness has caused it to be employed commonly in patents" (*id.*). On appeal, the Assistant Commissioner affirmed (R. 232-239), ruling that " 'Cube Steak' indicates a type of meat emanating from many sources and does not function to indicate origin or distinguish the product of any particular manufacturer or merchant, but one which may readily be procured in any meat market. * * * if

generic as to this, it is equally generic as to the machine" (R. 238); that "there is nothing to show that the mark has become distinctive" (R. 238); and that "if there were doubt as to its generic nature, it is merely descriptive and registration must necessarily be refused on this ground" (R. 239).

Petitioners then instituted a suit in the United States District Court for the District of Columbia under R.S. 4915, 35 U.S.C. (1946 Ed.) 63 [2] against the Commissioner of Patents to require him to register the trade-mark (R. 2-3). After trial, the district court dismissed the complaint (R. 8-9), holding that although the words "Cube Steak" were first used by petitioners' predecessor in 1925 and no one had previously used the words, "the words now appear to be identified as the name of the product and not the producer" (R. 4-5, 7) and the mark "indicates a type of meat emanating from many sources and does not function to indicate origin or to distinguish the product of any particular manufacturer or merchant, but one which may readily be procured in any meat market." (R. 7)

In affirming, the court of appeals ruled that the evidence sustained the district court's finding that "Cube Steak" now designates a type of meat that

[2] R. S. 4915, which had been made applicable to trade-mark proceedings by Section 21 of the Lanham Act (15 U.S.C. 1071), was repealed, effective January 1, 1953, by Section 5 of the Act of July 19, 1952, 66 Stat. 792, 815-816, which revised and reenacted into positive law Title 35 of the United States Code. Existing rights and liabilities were not affected by the repeal. Its provisions were reenacted into law, with changes not material here, as §§ 145 and 146 of Title 35. 66 Stat. 803.

comes from many different sources (R. 241) and also declared that the finding that the petitioners had failed to show that the mark "Cube Steak" had become distinctive of petitioners' goods in commerce was "entirely consistent with the evidence," even assuming that the goods in commerce were the tenderizing machines and that the "public" consisted of those who might purchase the machines (R. 242). "Notwithstanding that the term originally designated [petitioners'] machines and the products of these machines, [petitioners] did not acquire an exclusive right to apply the name after it became generic and no longer distinctive of their goods" (R. 241).

ARGUMENT

1. Section 2(f) of the Trade-Mark Act of 1946, *supra*, pp. 2-3, authorizes the registration only of a mark which *has become distinctive* of the applicant's goods in commerce.[3] It does not require the registration of a mark which at the time of application has deteriorated and become generic, so that the mark has ceased to indicate the goods of the user of the mark. Cf. *Kellogg Co.* v. *Nat. Biscuit Co.*, 305 U. S. 111, 118. If the mark has ceased to be distinctive at the time of application, there does not arise any question of an abandonment within the meaning of Section 45 of the Trade-

[3] Cf. *Coca-Cola Co.* v. *Koke Co.*, 254 U. S. 143, 145.

The right to registration being statutory, the applicant must satisfy the statutory conditions for registration. *Trustees for A. P. Shoe Patents* v. *J. McCreery & Co.*, 49 F. 2d 1068, 1070 (C. C. P. A.); *Philadelphia Inquirer Co.* v. *Coe*, 38 F. Supp. 427, 431 (D. D. C.), affirmed, 133 F. 2d 385 (C. A. D. C.), certiorari denied, 318 U. S. 793.

Mark Act of 1946, 60 Stat. 443, 15 U.S.C. 1127.[4] Section 45(b), relied on by petitioners (Pet. 16), applies to registrants rather than to applicants. Petitioners confuse a registrant's abandonment of a registered trade-mark with the requisites for compelling registration of a mark which has lost its distinctiveness as an indication of origin, before registration is sought. Cf. *Dupont Cellophane Co.* v. *Waxed Products Co.*, 85 F. 2d 75 (C.A. 2), certiorari denied, 304 U. S. 575; *Mission Dry Corp.* v. *Seven-Up Co.*, 193 F. 2d 201 (C.C.P.A.)

The court of appeals' opinion discloses that for the purposes of its decision it was willing to assume, with petitioners, that the "goods in commerce"—as to which the trade-mark must be "distinctive" in order to be registered—referred to the tenderizing machines rather than to the meat, and that the "public"—which must consider the mark "distinctive"—included only those who might purchase the machines (see R. 241-242). Thus, contrary to petitioners' interpretation (Pet. 9), the court of appeals, in holding that the mark was unregistrable, did not adopt an understanding-of-the-general-public test but looked to the understanding of

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[4] Section 45, so far as pertinent, provides that a mark should be deemed to be "abandoned":

> (a) When its use has been discontinued with intent not to resume. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie abandonment.
>
> (b) When any course of conduct of the registrant, including acts of omission as well as commission, causes the mark to lose its significance as an indication of origin.

people in the trade. Cf. *Bayer Co., Inc.* v. *United Drug Co.*, 272 Fed. 505 (S.D. N.Y) ("consuming public" and "trade" tests applied to the respective classes of buyers in suit to enjoin infringement of common-law trademark "aspirin"); but cf. *Durable Toy & Novelty Corp.* v. *J. Chein & Co.*, 133 F. 2d 853, 854 (C.A. 2), certiorari denied, 320 U. S. 211 ("trade" test for toy banks considered of little value, court observing that buyers of toys for retail dealers "do not buy on the faith of a trade-mark, but are always directly acquainted with the seller with whom they deal"). The court below did regard it as doubtful that "Cube Steak" related to the meat-tenderizing machines rather than the meat (R. 241), but, assuming *arguendo* in petitioners' favor that the words did designate the machines and that the "public" consisted only of those in the market for such machines, it nevertheless held that, as a matter of fact, the petitioners had failed to establish that "Cube Steak" had become distinctive of petitioners' machines in commerce in the understanding of those in the trade.[5]

Since petitioners' general theory was thus

[5] The court of appeals agreed that limited registration might be possible under Section 2(f) if customers for the machines regarded the mark "Cube Steak" as pointing distinctly to petitioners as producers, and if the mark was not merely descriptive. (R. 241-242). But petitioners "failed to show clearly that this is the factual situation" (R. 242). Cf. *Skinner Mfg. Co.* v. *General Food Sales Co.*, 52 F. Supp. 432, 448 (D. Neb.), affirmed, 143 F. 2d 895 (C.A. 8), certiorari denied, 323 U. S. 766. Of course, the fact that some persons, like the witnesses called, may have taken the term to mean petitioners' goods would not prevent it from being generic. *Dupont Cellophane Co.* v. *Waxed Products Co.*, 85 F. 2d 75 (C.A. 2), certiorari denied, 304 U. S. 575.

adopted, the issue comes down to one of evidence. Both courts found that petitioners, at the close of their evidence, had failed to make out a distinctive mark such as would warrant an order directing the Commissioner of Patents to register the trademark. The concurrent findings of the two courts below, agreeing with the Examiner and the Assistant Commissioner, will not be reviewed by this Court in the absence of exceptional error. *Comstock* v. *Group of Investors,* 335 U. S. 211, 214; *Faulkner* v. *Gibbs,* 338 U. S. 267, 268; *General Pictures Co.* v. *Western Electric Co.,* 304 U. S. 175, 178. Petitioners demonstrate no such error by placing a higher value on their evidence than the courts below were prepared to give. [6]

2. For this reason—that the concurrent findings below reject the factual basis of petitioners' claim

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[6] That some retailers preferred to buy their peace, by settlements, has only limited persuasiveness. Likewise, the generic name of "tenderizing machines" or "meat tenderers", stressed by petitioners, falls measurably short of proving that no other generic names for the goods exist, such as "cube steak machines".

Moreover, even convincing testimony that "Cube Steak" means petitioners' machine could not alter the fact that "Cube Steak Machine" is a designation which any manufacturer of the machine of petitioners' expired patent (R. 85; Pet. 4) is free to use on his machine. See *Kellogg Co.* v. *Nat. Biscuit Co.,* 305 U. S. 111, 118; *Singer M'f'g. Co.* v. *June M'f'g. Co.,* 163 U. S. 169, 185; *Amiesite Asphalt Co.* v. *Interstate Amiesite Co.,* 72 F. 2d 946, 947-8 (C.A. 3). A mark which any manufacturer would be at liberty to use would not be distinctive of the goods of any one manufacturer. An applicant must in general state that he is the owner of the mark sought to be registered and that "no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use such mark in commerce * * *." Section 1 of the Trade-Mark Act of 1946, 15 U. S. C. 1051.

(even on their own theory)—it is idle to argue (Pet. 19-20) that the denial of registration deprives them of very valuable substantive rights, or "confiscates" their mark. That argument not only treats a contested claim to registration as an incontestable, exclusive right, but also disregards the fact that registration under previous acts conferred no substantive right on petitioners but only a procedural advantage. *Armstrong Co.* v. *Nu-Enamel Corp.*, 305 U. S. 315, 322; *Best & Co.* v. *Miller*, 167 F. 2d 374, 376 (C.A. 2), certiorari denied, 335 U. S. 818; *Walgreen Drug Stores* v. *Obear-Nester Glass Co.*, 113 F. 2d 956, 960 (C.A. 8), certiorari denied, 311 U. S. 708; *Curtis-Stephens-Embry Co.* v. *Pro-Tek-Toe Skate Stop Co.*, 199 F. 2d 407, 412 (C.A. 8).[7]

3. It is also appropriate to point out an additional factor involved in this case. The district court specifically found (R. 7)—and the court below agreed (R. 241)—that the term "Cube Steak" now designates and means to the general public a type of meat that comes from many different sources. Others compete with petitioners in manufacturing tenderizing machines and at least one of petitioners' "Cube Steak Machine" patents has expired (see fn. 6, *supra*, p. 8). Since the term

[7] The issue is not whether petitioners should lose any trade-mark rights they may have possessed before filing the application in suit but rather whether they are entitled to the additional benefits of trade-mark registration. Whatever rights they had already, they may continue to enjoy without the registration sought by the application, for the right to use a trade-mark and the statutory right to register it are two different things.

"cube steak" has generic meaning for the consuming public and no longer is distinctive (as far as the general public is concerned), of petitioners' goods, petitioners are not entitled to a monopoly to fence out competitors who have equal rights to satisfy the demand for cube steak machines.[8] Cf. *Warner & Co.* v. *Lilly & Co.*, 265 U. S. 526, 528; *Standard Paint Co.* v. *Trinidad Asph. Co.*, 220 U. S. 446, 453; *Elgin Nat'l Watch Co.* v. *Illinois Watch Case Co.*, 179 U. S. 665, 673; *Canal Co.* v. *Clark*, 13 Wall. 311, 323; *Skinner Mfg. Co.* v. *Kellogg Sales Co.*, 143 F. 2d 895, 898 (C.A. 8), certiorari denied, 323 U. S. 766. To register the petitioners' mark in these circumstances would foster the misconception that only steak treated by their machines may be sold as "cube steak" (*Singer M'f'g. Co.* v. *June M'f'g. Co.*, 163 U. S. 169, 185-186; *Beckwith* v. *Commr. of Patents*, 252 U. S. 538; *Durable Toy & Novelty Corp.* v. *J. Chein & Co.*, 133 F. 2d 853, 854 (C.A. 2), certiorari denied, 320 U. S. 211),[9] a result

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[8] "It is unwise to risk the development of a situation in which those attempting to market their goods will find that they can not use apt normal words or phrases in depicting or characterizing articles because of language preemptions by others." *Telechron, Inc.* v. *Telicon Corp.*, 198 F. 2d 903, 906 (C.A. 3).

[9] The right to make an article implies the right to use words which aptly describe it and its product. *Singer M'f'g. Co.* v. *June M'f'g. Co.*, 163 U. S. 169, 185-186; *Beckwith* v. *Commr. of Patents*, 252 U. S. 538, 543-4; *Warner & Co.* v. *Lilly & Co.*, 265 U. S. 526, 528; *Basic Food Materials* v. *Keyes Fibre Co.*, 162 F. 2d 422 (C. C. P. A.); *Schulmerich Electronics* v. *J. C. Deagan, Inc.*, 202 F. 2d 772, 777 (C. C. P. A.); *Ippolito* v. *Nancy Ann Dressed Dolls*, 184 F. 2d 201, 203 (C. C. P. A.); *Dixie Rose Nursery* v. *Coe*, 131 F. 2d 446 (C. A. D. C.), certiorari denied, 318 U. S. 782.

directly contrary to the long recognized rule that "No one can claim protection for the exclusive use of a trade-mark or trade-name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected, for competition would be destroyed." *Canal Company* v. *Clark,* 13 Wall. 311, 323.

CONCLUSION

The decision of the court below is clearly correct and in conformity with the Trade-Mark Act of 1946. Further review of the evidence is not warranted. It is respectfully submitted, therefore, that the petition for a writ of certiorari should be denied.

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JANUARY, 1954.

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